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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,971	12/23/1999	ALBHY GALUTEN	9386/1F051-U	8165

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/471,971

Applicant(s)

GALUTEN ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Affidavit, Exhibit, or Request for Reconsideration***

The Declaration filed on 17 June 2002 under 37 CFR 1.131 has been considered but is ineffective to overcome Downs et al and Business Wire references: evidence of conception and completion of the invention in this country or in a NAFTA or WTO member country is lacking. It is also noted that the Declaration is lacking a dated signature by each inventor.

### ***Response to Arguments***

Applicant's arguments filed 17 June 2002 have been fully considered but they are not persuasive. The Applicant traverses the 102(e) rejection of Claims 3-37, 42-76, 81, and 83, and the 103(a) rejection of Claims 38-41, 77-80, 82 and 84 on the grounds of a Declaration submitted under 37 CFR 1.131 that antedates cited reference of Downs et al, patent number 6,226,618 and Business Wire. The Declaration is ineffective in removing the cited references as noted above under "Affidavit, Exhibit, or Request for Reconsideration." All claims pending, Claims 3-84, stand rejected. This is a final rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. **Claims 3-37, 42-76, 81, and 83 are rejected under U.S.C. 35 102(e) as being anticipated by Downs et al, patent number 6,226,618.**

As per Claims 3-37, 42-76, 81 and 83, Downs et al teaches all the claims above by disclosing a secure digital electronic content delivery system, method, and computer readable medium of distributing content to a user's system (see at least abstract; Fig. 1a-c (100); Fig. 1d (111, 109); col. 6, lines 34-64) with said content selected via lists, catalogs (see at least Fig. 16 (1601-1605); col. 4, lines 46-47) or in response to promotion offers through a retail web module and site (see at least Fig. 1a (156) col. 67, lines 63-67; col. 1-46). Distribution of audio,

programs, multimedia, video or other types of content is supported (see at least col. 8, lines 26-39). Downs et al teaches a clearinghouse responsible for granting access permissions, the monitoring of content usage (see at least abstract; col. 6, lines 65-67; col. 7, lines 1-67; col. 8, lines 1-15), and billing and invoicing (see at least col. 42, lines 35-63; col. 47, lines 26-57). Downs et al further teaches preparation and management of content from content providers (see at least Fig. 1a (123); col. 48, lines 27-67; col. 49, lines 1-10) via a workflow manager (see at least Fig. 1 (154, 155); col. 49, lines 12-33) and the use of a end user player application (see at least col. 83, lines 26-67; col. 84, lines 1-67; col. 85, lines 1-52).

Downs et al teaches electronic contracts that governs usage conditions and license control between content providers, electronic stores, consumers, and the clearinghouse responsible for usage condition validations (see at least Fig. 5 (101, 103, 105, 109); col. 7, lines 2-18; col. 21, line 22; col. 22, line 25, col. 23, line 1). Access rights can be for "n" number of plays or for an unlimited number of plays (see at least col. 7, lines 7; col. 79, lines 57-60). Downs et al teaches special offers, or candidate offers, from content providers and/or retailers, promotion thereof to end users, and validation by the clearinghouse (see at least col. 10, lines 49-67; col. 67, lines 63-67; col. 68, lines 1-46).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 38-41, 77-80, 82, and 84 are rejected under U.S.C. 35 103(a) as being unpatentable over Downs et al, in view of Business Wire ("NetWaveInc.com<sup>TM</sup> Kicks Off QuickBuy<sup>TM</sup> Enabling Faster, Easier, Safer E-Business," 7 October 1998, 1337, Dialog File 148 #10507244).**

Downs et al teaches an open system architecture, use of the Internet, end user or consumer devices comprising personal computers or Internet appliances (see at least col. 11, lines 29-34), web sites and web browsers (see at least Fig. 10 (191); col. 79, lines 26-40), and email as a means for retailers to send product selections to the consumer (see at least col. 3, lines 12-14). Downs et al further teaches sending a content reference to a first consumer (see at least col. 26, lines 41-43) but does not teach sending a content reference from a first consumer to a second consumer. Business Wire teaches visual link object technology that enables merchants to present their goods as portable, "buyable" objects that look like any other standard web image to web browsers. The buyable items can be sent via e-mail from one consumer to another consumer, such as friend-to-friend, relatives or other enthusiasts. Therefore it would have been

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obvious to one of ordinary skill to modify the system and method of Downs et al to incorporate portable objects as taught by Business Wire, in order to increase product and exposure by tapping the potential referral base of existing customers.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***


***Washington D.C. 20231***

or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP  
September 6, 2002

  
JEFFREY A. SMITH  
PRIMARY EXAMINER